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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,263	01/27/2004	James E. Barker	EDE / 03CIP	9573
26875	7590	10/03/2005	EXAMINER NGUYEN, CHI Q	
WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			ART UNIT 3635	PAPER NUMBER

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/765,263	BARKER, JAMES E.
	Examiner	Art Unit
	Chi Q. Nguyen	3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 27 January 2004.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) 21-27 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,3,5,7,8,10-12,14,15,17,18 and 20 is/are rejected.  
 7) Claim(s) 2,4,6,9,13,16 and 19 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 27 January 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 6/11/2004.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: attachment.

## DETAILED ACTION

This Office action is in response to the Applicant's continued application 10/765,263 filed on 1/27/2004.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121.

- I. Claims 1-20, drawn to apparatus of a module for a utility trenching and sidewalk system, classified in class 52, subclass 220.5.
- II. Claims 21-27, drawn to a method of forming a utility trenching and sidewalk system, classified in class 404.

The inventions I and II are related as process of making and product made. The inventions are distinct if either of the following can be shown:

- (1) that the process as claimed can be used to make other and materially different product or
- (2) that the product as claimed can be made by another and materially different process.

For instant case, the apparatus claims could be made by a method different than that group II such as using prefabricated concrete pipes to hide utility cable.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purpose as indicated is proper.

A telephone call was made to request an oral election on 9/26/2005, and the applicant elected group I (claims 1-20) without traverse for prosecution. And the claims 21-27 are being non-elective claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 7, 11, 12, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Pollock (US 5,613,339).

In regard claim 1, Pollock teaches a module comprising two opposed outer sidewalls 13a/19a, 13b/19b. Each of the sidewalls composed of inner, and outer portions 13a/19a and 13b/19b, respectively, and having a top end and a bottom end; a bottom wall 9 disposed proximate said bottom ends of said outer sidewalls and together with said outer sidewalls defining a channel having at least one interior compartment; at least one cover 7 configured to be removably received proximate said top ends of said outer sidewalls to enclose said channel; at least one cavity (see attached figure 1) formed in said sidewalls and said bottom wall; at least one aperture, open top (see attached figure 2) formed through said sidewalls and communicating with said cavity.

In regard claim 5, Pollock teaches the claimed invention as stated, wherein further comprising at least one inner sidewall 21 having a top end and a bottom end, said inner sidewall disposed between said outer sidewalls to thereby form at least two interior compartment (see attached figures 1 and 2). In regard claim 7, Pollock teaches the claimed invention as stated, wherein the channel is formed an integral molded shell, said molded shell defining said outer sidewalls, said bottom wall, and said inner sidewall. In regard claims 11, 12, Pollock teaches the claimed invention as stated, wherein further teaches fasteners 31 serve as reinforcing member and configured to be secured within said cavity (figure 3). In regard claim 14, Pollock teaches in figures 6 and

8, a module system comprises a plurality of modular arranged adjacent one another longitudinally end-to-end and each module unit comprising the structural elements (see above rejections of claim 1). And with regard claim 15, see rejections of claim 11 above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 10, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollock.

In regard claims 8, 20, Pollock teaches the claimed invention as stated, wherein the channel 9 is preferably extruded of a suitable synthetic resin, such as polyvinyl chloride (PVC) (see col. 5, lines 4-6). However, Pollock does not teach specifically the channel is formed from polyethylene. Examiner takes Official Notice the fact that polyethylene and PVC are originally formed from polymer chemical composition and would have functional equivalent because they would provide lightweight and good insulation for the module.

In regard claims 10, 17, Pollock teaches the claimed invention as stated, however, Pollock does not teach specifically at least one reference line disposed across the module between said outer sidewalls and oriented to facilitate subdividing the module into fractional piece. At the time of the invention, it would have been obvious to one having ordinary skill in the art to draw at least one reference line across one of the

module units for straight cut to have fractional piece for fitting into corner or desire application.

Claims 3, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollock in view of Gray (US 4,324,078).

In regard claims 3, and 18, Pollock teaches the claimed invention as stated. However, Pollock does not teach expressly the cover is formed from paving material, and the cavity disposed with concrete. Gray teaches flooring deck including a cover 15 made from paving material, such as concrete and cavity filled with concrete material 47 (see figures 1-3). At the time of the invention, it would have been obvious to one having ordinary skill in the art to modify the cover made from paving material and the cavity filled with concrete material. The motivation for doing so would have been to protect from severe weather and reinforcing the module system stronger.

#### ***Allowable Subject Matter***

Claims 2, 4, 6, 9, 13, 16, and 19 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lockard, Hornsby, Owen, Beamer, Barenwald, Beamer, Wirthwein, Parazader, Walker, and Brugger teach U-shaped channel for trenching system.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847, Mon-Thu (7:00-5:30), Fridays off or examiner's supervisor, Carl Friedman can be reached at (571) 272-6842. The examiner's right fax number is (571) 273-6847.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairdirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

9/29/2005  
*On*  
CQN



Carl D. Friedman  
Supervisory Patent Examiner  
Group 3600

